

Application No. 10/657,837
Response dated December 18, 2006
Reply to Final Office Action of August 23, 2006

REMARKS

Claims 1-29 are currently pending. Claims 3, 7, 10, 20-22 have been withdrawn as being directed to a non-elected species/invention. Reconsideration of the application in view of the current claims is respectfully requested and further in view of the following Remarks.

Information Disclosure Statement

Applicant would appreciate receiving confirmation that the references cited in the Information Disclosure Statement filed on March 8, 2005, June 17, 2005, September 20, 2005, and June 12, 2006 have been considered.

Rejections of Claims 1, 2, 4-6, 8, 9, 11-17, 19 Over Zang

The Examiner rejected claims 1, 2, 4-6, 8, 9, 11-17, 19 under 35 U.S.C. § 102(b) over Zang US 5,314,486 ("Zang"). Zang shows a metatarso-phalangeal joint prosthesis. Zang does not show a fastening element adapted to be removably attached to the vertebra or a prosthetic facet joint articulating surface dimensioned to replace all or a portion of a natural facet joint on the vertebra that is removably attaches to a structure that is itself removably attached to the fastening element, as recited in claim 1. In constructing the argument supporting his rejection, the Examiner arbitrarily chose to ignore these key claim recitations to reach the remarkable conclusion that the Zang prosthesis is capable of replacing all or a portion of a vertebral facet joint. (Final rejection, page 3.) The Examiner, however, has not pointed to any controlling authority for his position that the specific structural limitations of "adapted to be removably attached to the vertebra" and "dimensioned to replace all or a portion of a natural facet joint on the vertebra" may be ignored when construing the scope of this claim.

The Examiner appears to believe that Applicant's specification must recite the specific dimensions of a vertebral facet joint prosthesis in order for Applicant's claim to define over Zang's metatarso-phalangeal joint prosthesis. (Final rejection, page 2) Once again, the Examiner has not cited any legal support for this requirement. Applicant's specification meets the disclosure requirements of the first paragraph of 35 U.S.C. § 112, and Applicant's claims meet the

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definiteness requirements of the second paragraph of § 112. A skilled artisan would understand the meaning and scope of Applicant's claims after reading the specification, a fact tacitly admitted by the Examiner since there are no § 112 rejections or objections in the Examiner's action.

For these reasons, claim 1, and claims 2, 4-6, 8, 9, 11-19, and 23-29 which depend from it, are patentable over Zang under § 102(b).

Rejection of Claims 5, 6, and 18 Over Zang and Johnson

The Examiner rejected claims 5, 6 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Zang in view of Johnson US 5,609,641 ("Johnson"). Johnson's disclosure of a tibial prosthesis, however, does not remedy the deficiencies of Zang. Claims 5, 6 and 18 are patentable over Zang and Johnson for the reasons stated above with respect to claim 1.

Status of Claims 23-29

The Examiner's rejection did not specifically address claims 23-29. Applicant respectfully requests that the Examiner withdraw the finality of the previous rejection and to address all claims in the next office action so that Applicant will have a complete record from which to appeal.

CONCLUSION

For the foregoing reasons, Applicant requests the Examiner allow claims 1, 2, 4-6, 8, 9, 11-19, and 23-29 and advance the application to issuance.

Respectfully submitted,

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